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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,959	10/21/2003	Heinz Studer	33997.0091	4430
26712	7590	07/07/2005	EXAMINER	
HODGSON RUSS LLP			AMARI, ALESSANDRO V	
ONE M & T PLAZA				
SUITE 2000			ART UNIT	
BUFFALO, NY 14203-2391			PAPER NUMBER	
			2872	

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/689,959

Applicant(s)

STUDER ET AL.

Examiner

Alessandro V. Amari

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,8-10,13-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,8-10,13-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 5, 6, 8, 9, 13-16, 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fay et al US 5,009,488 in view of Stenzel EP 1205780.

In regard to claims 1, 13, 20 and 21, Fay et al discloses all of the limitations with the exception of the transponders and the reading unit. Specifically Fay et al discloses (see Figures 1, 3-5) a microscope or an assembly adapted to be held by a magazine of a microscope or a process for carrying out a selected investigation using a microscope comprising an optical path as shown in Figure 1; a magazine (52) having a plurality of receiving areas as shown in Figures 3 and 4; a plurality of assemblies (58), each of said plurality of assemblies being accommodated by a respective one of said plurality of receiving areas for selective positing in said optical path by operation of said magazine as shown in Figure 3, a plurality of markings (74) associated with one with each of said plurality of assemblies, a reader unit (76) for reading data from markings and conducting said investigation in accordance with said read data as described in column 3, lines 56-68 and column 4, lines 1-18. In regard to claims 20 and 21, Fay et al discloses (see Figures 1, 3-5 and 7) a computer executable process or computer readable storage medium storing computer executable instructions for performing steps

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of reading data associated with a filter (58) in an optical path of a microscope; reading filter data from a database, said filter data corresponding to a selected microscopy investigation; comparing said data with said filter data; and opening a shutter (77) in said optical path if said data provided match said filter data and is in said optical path as described in column 4, lines 44-68 and column 5, lines 1-20.

However, in regard to claims 1, and 13, Fay et al does not teach a plurality of transponders associated one with each of said plurality of assemblies, wherein each of said plurality of transponders includes stored data; and a reader unit for reading said stored data of a transponder associated with an assembly positioned in said optical path. Further, regarding claims 2 and 15, Fay et al does not further teach a writer unit for writing data into any one of said plurality of transponders. Further, in regard to claims 20 and 21, Fay et al does not teach reading data from a transponder associated with a filter.

In regard to claims 1 and 13, Stenzel does teach (see Figure 1) a plurality of transponders (6) associated one with each of said plurality of assemblies, wherein each of said plurality of transponders includes stored data; and a reader unit (7) for reading said stored data of a transponder associated with an assembly positioned in said optical path as described in column 4, lines 54-58 and column 5, lines 1-11.

Regarding claims 2 and 15, Stenzel does teach a writer unit for writing data into any one of said plurality of transponders as described in column 2, lines 49-58 and column 3, lines 1-35.

In regard to claims 20 and 21, Stenzel does teach reading data from a transponder associated with a filter as described in as described in column 2, lines 49-58 and column 3, lines 1-35.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the transponders of Stenzel in the microscope of Fay et al in order to provide for input of additional information or rewriting of data on filters or assemblies making possible improved automatic identification of filters or assemblies and their position in the beam path of the microscope.

Regarding claim 5, Fay et al further discloses a motor (62) connected to said magazine for moving said magazine as shown in Figure 7 and as described in column 3, lines 56-68 and column 4, lines 1-18.

Regarding claim 6, Fay et al discloses an electronic control unit (104, 106) for controlling processes as described in column 4, lines 63-68 and column 5, lines 1-20.

Regarding claims 8 and 16, Fay et al discloses that said microscope is designed for fluorescence measurements as described in column 2, lines 6-9.

Regarding claim 9, Fay et al discloses that said microscope is a stereomicroscope as described in column 3, lines 33-39.

Regarding claim 14, Fay et al further discloses the steps of reading reference data corresponding to said selected investigation, comparing said read data with said reference data and stopping said investigation if said read data does not match said reference data for said selected investigation as shown in Figure 8.

Regarding claim 18, Fay et al further discloses the step of storing said read data as shown in Figures 7 and 8 and as described in column 4, lines 63-68, column 5, lines 1-20 and column 6, lines 4-14.

Regarding claim 19, Fay et al further discloses the step of using said read data that have been stored to provide operational data as shown in Figure 8 and as described in column 4, lines 63-68, column 5, lines 1-20 and column 6, lines 4-14.

3. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ammann et al WO99/13370 in view of Stenzel EP 1205780.

In regard to claim 10, Amann et al teaches (see Figures 6, 16a-16c) a filter magazine (17) for use in a microscope comprising a plurality of receiving areas (19b-h) and at least one filter carrier (17) each said filter carrier being accommodated by a respective one of said plurality of receiving areas and carrying at least one filter (15) intended to be positioned in an optical path of said microscope by operation of said magazine.

However, in regard to claim 10, Amann et al does not teach that the microscope has a reader unit for reading data stored in a transponder or carrying a transponder with which filter is associated wherein the transponder stores data indicating characteristics of said filter associated therewith.

In regard to claim 10, Stenzel et al teaches (see Figure 1) that the microscope has a reader unit (7) for reading data stored in a transponder or carrying a transponder (6) with which filter is associated wherein the transponder stores data indicating characteristics of said filter associated therewith as described in column 3, lines 36-50.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the reader and transponder of Stenzel in the microscope of Ammann et al in order to provide for input of additional information or rewriting of data on filters or assemblies making possible improved automatic identification of filters or assemblies and their position in the beam path of the microscope.

Response to Arguments

4. Applicant's arguments filed 2 May 2005 have been fully considered but they are not persuasive.

The applicant argues that Stenzel does not suggest associating transponders with filters, but only with objectives and the reader unit of Stenzel does not read stored data of a transponder associated with a filter.

In response to this argument, the Examiner directs the applicants attention to column 3, lines 36-50 of Stenzel which states:

Also, alternatively or additionally, the wavelength and/or line width of filters or filter systems could be stored in a transponder.

Therefore, Stenzel does indeed teach that data stored in a transponder is associated with a filter.

The applicant further argues that Fay et al does not teach that the shutter can only be opened once a correct filter is in the optical path but that even if the actual characteristics of the filter do not match what is expected from the filter identification code the shutter is nevertheless enabled.

In response to this argument, the applicants attention is directed to column 5, lines 6-19 which state:

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The entire system is controlled by central processing unit 106 through digital to analog converters of converter unit 108. The CPU 106 controls the shutter 77, the shutter 90, and the focusing motor 44 and, through the filter controller 104, it controls the filter motor 62. The CPU receives an acknowledge signal from the filter controller when a selected filter is positioned in the optic path and receives position input from the eddy current sensor electronics 98 through an analog to digital converter of converter unit 108. Under control of the cpu, signals from the camera 30 are received through the analog to digital converters of unit 108 and are stored in the memory 109 for processing.

Further as shown in Figure 8B, the flow chart indicates that the processor goes through the step of changing filters by rotating filter wheel before opening the excitation light shutter. Therefore, Fay does teach that the shutter can only be opened once a correct filter is in the optical path.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alessandro V. Amari whose telephone number is (571) 272-2306. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ava:lvj
29 June 2005


MARK A. ROBINSON
PRIMARY EXAMINER